

Appln. No. 09/435,770
Amd. dated November 1, 2004
Reply to Office Action of July 1, 2004

REMARKS

The Office Action has been carefully reviewed. No claim is allowed. Claims 1, 9, and 13 presently appear in this application and define patentable subject matter warranting their allowance. Reconsideration and allowance are hereby respectfully solicited.

Claims 1, 9 and 13 have been rejected under 35 U.S.C. §101. This rejection is obviated by the amendment to the claims to recite "purified".

Claims 1, 9, and 13 have been rejected under 35 U.S.C. §112, first paragraph, because the examiner states the specification, while being enabling for an isolated non-reducing saccharide-forming enzyme obtainable from *Arthrobacter* sp. S34 (FERM BP-6450) comprising an amino acid sequence as set forth in SEQ ID NO:1, does not reasonably provide enablement for any non-reducing saccharide-forming enzyme having an amino acid sequence that is at least 80% identical to SEQ ID NO:1 or any non-reducing saccharide-forming enzyme obtainable from any microorganism of the genus *Arthrobacter*. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. This rejection is respectfully traversed.

The rejection as it relates to claim 1 is obviated by the amendment to claim 1.

With regard to claim 13, applicants believe that a fingerprint of the claimed enzyme from the genus *Arthrobacter* is

Appln. No. 09/435,770

Amd. dated November 1, 2004

Reply to Office Action of July 1, 2004

provided in claim 13. One of skill in the art is fully enabled to determine if a non-reducing saccharide-forming enzyme isolated from a species of *Arthrobacter* falls within the fingerprint recited in claim 13. Moreover, claim 9, which is dependent from claim 13, further defines the *Arthrobacter* species. Certainly, those of skill in the art can isolate the presently claimed enzyme from a specific species of *Arthrobacter* taught in the specification to produce the presently claimed enzyme.

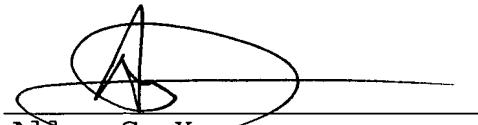
Reconsideration and withdrawal of the rejection are therefore respectfully requested.

In view of the above, the claims comply with 35 U.S.C. §112 and define patentable subject matter warranting their allowance. Favorable consideration and early allowance are earnestly urged.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant(s)

By



Allen C. Yun
Registration No. 37,971

ACY:pp

Telephone No.: (202) 628-5197

Facsimile No.: (202) 737-3528

G:\BN\S\SUMA\Yamamoto16A\pto\AMD OA 7-1-04.doc